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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/000,366	01/28/98	HOASHI	M HOASHI=2

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IM22/0917

EXAMINER

BECKER, D

ART UNIT PAPER NUMBER

1761

DATE MAILED: 09/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/000,366

Applicant(s)

Hoashi et al

Examiner

Drew Becker

Group Art Unit

1761

☒ Responsive to communication(s) filed on Aug 10, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 3-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 3-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on August 10, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/000,366 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-7, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al in view of JP 60-70049.

Katoh et al teach the concepts of crushing and thawing frozen fish meats as a preliminary step (column 3, lines 31-37), milling into pieces of between 3.0 and 10 mm in size (column 7, line 4), mixing in additives with a mixer of the same type as that of the applicants' (column 7, line 10; Figure 1), and thawing (column 3, line 35). It would have been obvious to one of ordinary skill in the art to thaw the fish of Katoh et al without mashing since thawing by simply leaving a frozen product in a warmer environment is a commonly known method of thawing. Katoh et al do not

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explicitly teach the concept of first freezing followed by grinding of the fish meats. JP 60-70049 teaches the concept of grinding already frozen fish meats into particles (claim) by use of a cutter (page 3, lines 24-30). It would have been obvious to one of ordinary skill in the art to incorporate the freezing then milling method of JP 60-70049 into the method of Katoh et al since Katoh et al already include the steps of crushing and freezing but not explicitly in the order of JP 60-70049 and thawing after size reduction takes less time because the decreased thickness of the fish aids conductive heat transfer. It would have been obvious to one of ordinary skill in the art to combine the cutter of JP 60-70049 with the uniform milling of Katoh et al since a more gradual size reduction process by use of a cutter would be beneficial to the service life of the milling machinery.

4. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al and JP 60-70049 in view of JP 06-133739.

Katoh et al and JP 60-70049 teach the concepts mentioned above. Katoh et al also teach the concepts of producing kamaboko by molding the ground fish (column 6, line 52), heating the ground fish while in the mold for network formation (column 6, line 60), and further heating (column 6, line 62). Katoh et al and JP 60-70049 do not teach the concept of heating the fish paste by passing electric current through the fish. JP 06-133739 teaches the concept of heating fish by passing electric current through it (Constitution). It would have been obvious to one of ordinary skill in the art to incorporate the electric heating of JP 06-133739 into the method of

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Katoh et al and JP 60-70049 since ohmic heating is a commonly known method of heating and does not require a heating medium, such as oil or steam, to contact the food.

Response to Arguments

5. Applicant's arguments filed March 1, 1999 have been fully considered but they are not persuasive.

In response to applicant's argument that Katoh et al, JP 60-70049, and JP 61-33739 are not capable of being combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, Katoh et al teach a method of uniformly milling ground fish prior to mixing and making kamaboko (column 7, lines 3-23), JP 60-70049 teach shearing and grinding frozen ground fish prior to thawing (page 1, claim; page 3, lines 20-24), and JP 06-133739 teach a method of heating fish (constitution) which taken as a whole teach that frozen ground fish can be milled before thawing. It would have been obvious to one of ordinary skill in the art to incorporate the grinding of frozen ground fish meat in the manner of JP 60-70049 into the method of Katoh et al since JP 60-70049 teach the advantage of a higher deformation ratio and excellent tasting touch when grinding unthawed frozen ground fish meat (page 3, lines 20-24).

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Canadian Patent No. 1,213,170 teaches a method of milling frozen ground meat (page 19, claims 1-2) and Partyka [Pat. No. 3,607,315] teaches a method of comminuting frozen seafood.

7. This is a continuation of applicant's earlier Application No. 09/000,366. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew Becker whose telephone number is (703) 305-0300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Lacey, can be reached on (703)-308-3535. The fax phone number for this Group is (703)-305-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Drew Becker

September 16, 1999


David Lacey
Supervisory Patent Examiner
Technology Center 1700

9/16/99